

Remarks

The Examiner has objected to the Application as lacking the written consent of all assignees owning an undivided interest in the patent. A new Consent of Assignee of Record Under 37 CFR 3.73, dated and signed, is filed herewith.

The Examiner has noted that the present application must be cross-referenced in the parent reissue case. [A certificate of correction] has been filed in the parent case to satisfy this requirement.

The Examiner has objected to the reissue oath/declaration because it fails to identify at least one error which is relied upon to support the reissue application. A newly executed Supplemental Reissue Declaration of Lars Severinsson specifying at least one such error is filed herewith (see Paragraph 5 thereof).

Claim 25 has been rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. Applicant respectfully traverses this rejection and respectfully asks the Examiner to reconsider his position.

The recapture rule comprises a two part test. The first step is to "determine whether and in what aspect the reissue claims are broader than the patent claims." *In re Clement*, 131 F.3d 1464, 1468 (Fed. Cir. 1997). This step requires focusing on, for example, deleted limitations in the reissue claims that were present in the original patent claims. In this respect, the claims as a whole are broader only with respect to the elements having the deleted or broadened limitations. The remaining elements should be interpreted to have the same scope as the issued claims.

In the present application, the Examiner has asserted that the current claims are broader in that the present reissue claims do not require a cover. Applicant agrees with the Examiner on this point.

The second step is to "determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection." *In re Clement*, 131 F.3d 1464, 1468-69 (Fed. Cir. 1997) citing *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995-96 (Fed. Cir. 1993).

Applicant respectfully suggests that the cover does not relate to surrendered subject matter, as the cover itself was not added and no arguments about the presence of the cover itself were made in an effort to overcome a prior art rejection.

Applicant notes the Examiner's citation of the specification, page 2, line 29: "...but the cover and the rest of the mechanism are also **held together as a unit...**". Applicant also notes the Examiner's citation of page 6 of Applicant's remarks in the original parent case 08/817769: "Parent claim 1 is amended to better structurally define applicant's novel feature wherein the housing and cover members are structured with the entire braking unit carried by the cover independently from the housing to be inserted as a unit." [The Examiner has apparently construed these statements to mean that a cover is required as part of the novelty of the invention. Applicant respectfully disagrees.

As the Examiner has himself notices (as indicated by his highlighting of the phrase in the quoted portion of the specification), the novelty of the invention is that the brake mechanism is "held together as a unit." Similarly, Applicant suggests that the relevant phrase of the quoted portion of Applicant's remarks in

the original parent case 08/817769 is as follows: that the braking unit be separate "from the housing to be inserted as a unit". This interpretation is supported by a reading of Applicants arguments as a whole for patentability in its previous responses to office actions. Applicant consistently argued for patentability on the basis that the brake mechanism be held together as a unit. The presence of the cover itself was never asserted to contribute to patentability, and indeed it could not have been since the prior art clearly disclosed a brake system having a housing and a cover (see for example U.S. Patent No. 5,927,445 to Bieker, which was brought to the Examiner's attention in the present application via an IDS). Thus, it was Applicant's assertion that a preassembled brake mechanism held together as a unit was patentable. That the preassembled brake mechanism must include a cover was not argued as making the invention patentable, and indeed was not what made the invention patentable. As such, removal of the cover in the present application does not constitute impermissible recapture, as the cover does not relate to surrendered subject matter. If the cover was present, it would form part of the preassembled brake mechanism -- however, there was no argument made that the cover itself was required for novelty or somehow distinguished over the prior art.

In a case similar to the present situation, where the Federal Circuit concluded a patentee was not attempting to recapture subject matter and allowed the reissue claims, the court determined that the patentee added a "plurality of feedlines" in an effort to overcome prior art, but that a cylindrical configuration limitation was neither added in an effort to overcome a prior art rejection nor argued to distinguish the claims from a reference. *Ball Corp. v. United States*, 729 F.2d 1429, 1437 (Fed. Cir. 1984). As discussed above, the cover here, although clearly present in the claims of the original patent, was neither added in an effort to overcome prior art nor argued to distinguish the claims from a prior art reference. "Recapture rule may not apply if reissue claim is broader in a manner that does not attempt to reclaim what was surrendered earlier..." *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 992 (Fed. Cir. 1993).

Moreover, the Examiner has already expressed that claims directed to the wedge configuration are patentable over the prior art without the inclusion of a cover.

For the foregoing reasons, Applicant respectfully submits that Claims 25-28, all of the claims currently pending, are patentable over the references of record

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and do not attempt to impermissibly recapture surrendered subject matter, and
therefore earnestly solicits allowance of the same.

Respectfully submitted,



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